

**REMARKS/ARGUMENTS**

In response to the Office Action dated October 20, 2003, claims 1, 3, 8, 11, 16, 21 and 29-36 are amended. Claims 1-36 are now active in this application. No new matter has been added.

The indication that claims 3-7 and 9 would be allowable if the noted objection is overcome, and that claims 22-28 and 30-36 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

**OBJECTION TO THE CLAIMS**

Claims 1, 3, 8, 11, 16, 21 and 29 are objected to for using the term "the cell(s)", which is not the same as the previously introduced term "cells". By this response, each of these claims is amended to recite "the cells" as suggested by the Examiner.

**DOUBLE PATENTING**

Claims 1, 2, 8, 10 and 11-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of USPN 6,377,757 in view of Evans (USPN 3,612,758).

A terminal disclaimer is submitted with this response. Consequently, withdrawal of this rejection is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 103**

I. Claims 1, 2, 11-21 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheridan (USPN 4,143,103) in view of Evans. The Examiner admits that Sheridan does not expressly teach that in image display, strength of the electric field to be applied to the developer is 0.3V/ $\mu$ m to 3.0 V/ $\mu$ m, and does not teach having a periphery surrounded by a partition wall with a dry developer contained in each of the cell(s). Evans is relied upon by the Examiner to teach a color display device employing electrophoretic migration of color pigment particles to form an image display panel (abstract), that the field necessary for particle migration is small (on the order of 0.5 V/micron); having a periphery surrounded by a partition wall (insulating material 13); and a dry developer contained in each of the cell(s). The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to include the teaching of Evans in the device of Sheridan to meet the terms of the claims.

The rejections are respectfully traversed.

Each of independent claims 1, 11, 16, 21 and 29 requires, *inter alia*, the image display medium to have a dry developer with:

the dry developer containing at least ***two kinds of*** frictionally chargeable dry developing ***particles*** having different chargeable polarities and different optical reflection densities...

Neither Sheridan nor Evans discloses or suggests an image display medium including ***two kinds of particles***, as required by independent claims 1, 11, 16, 21 and 29.

Independent claim 11 requires, *inter alia*:

initializing the reversible image display medium by ***stirring the developer*** in the image display medium before image display on the display medium...

Neither Sheridan nor Evans discloses or suggests “*stiring the developer*”, as required by independent claim 11. .

In view of the above, it is clear that the Examiner has not establish a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis. Specifically, in rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for every claim limitation. ***Smith Industries Medical Systems v. Vital Signs***, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged.

Thus, even if the teaching of Evans were combined with the disclosure of Sheridan, the inventions recited in independent claims 1, 11, 16, 21 and 29 do not result. Consequently, claims 1, 2, 11-21 and 29 are patentable over Sheridan and Evans, and their allowance is respectfully solicited.

II. Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheridan in view of Moore (USPN 6,611,100). The Examiner admits that Sheridan does not teach having a periphery surrounded b a partition wall; a dry developer contained in each of the cells; and having a holding potential to hold the displayed image after completion of application of electrostatic field. Moore is relied upon by the Examiner to teach an electrophoretic display that includes partitions and wherein a holding potential is being used to the displayed images. The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to include the teaching of Moore in the device of Sheridan to meet the terms of the claims.

The rejections are respectfully traversed.

Similar to independent claims 1, 11, 16, 21 and 29, independent claim 8 requires, *inter alia*, the image display medium to have a dry developer with:

the dry developer containing at least *two kinds of* frictionally chargeable dry developing *particles* having different chargeable polarities and different optical reflection densities...

Neither Sheridan nor Moore discloses or suggests an image display medium including *two kinds of particles*, as required by independent claim 8.

Similar to the reasoning expressed in I, above, it is clear that the Examiner has not establish a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis. Consequently, even if the teaching of Moore were combined with the disclosure of Sheridan, the invention recited in independent claims 8 does not result.

Furthermore, the image forming process disclosed in Moore is so remarkably different from the image forming process disclosed in Sheridan that a person of ordinary skill in the art would have no realistic motivation to combine the barrier walls 68 in hollow tubes 27 and the holding potential taught in Moore with the panel display of Sheridan with a reasonable expectation of achieving a particular benefit in Sheridan. In particular, given the disparate image forming process disclosed in Moore from that disclosed in Sheridan, no evidence is present on this record that the holding potential used to display images in the arrangement of Moore would have any applicability to the image forming process disclosed in Sheridan.

It is noted that MPEP § 2143.01, last paragraph, states that the proposed modification cannot change the principle of operation of a reference. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention

being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." Additionally, the second to the last paragraph in MPEP § 2143.01 states that the **"proposed modification cannot render the prior art unsatisfactory for its intended purpose"**.

Applicants would also rely upon the decisions by the Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000) and *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000), wherein it was held that generalizations do not establish the requisite realistic motivation. Rather, it is incumbent upon the Examiner to make particular findings as to a specific understanding or specific technological principle, and to provide evidence of such findings, to establish the requisite realistic motivational element.

Applicants submit that the Examiner did not unearth the requisite motivational element from the applied prior art itself. Rather, the Examiner engaged in improper generalizations after retrospectively assessing Applicants' invention. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). The only apparent basis for the motivation to combine the teaching of Moore with the disclosure of Sheridan to result in the invention recited in independent claim 8 is found in Applicants disclosure, which can not properly be relied upon by the Examiner to establish the requisite motivational element. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985). Thus, the Examiner also did not establish a *prima facie* case of obviousness with respect to independent claim 8 under 35 U.S.C. § 103 for lack of the requisite realistic motivation.

In view of the above, independent claim 8, as well as dependent claim 10, are patentable over Sheridan and Moore, and their allowance is respectfully solicited also.

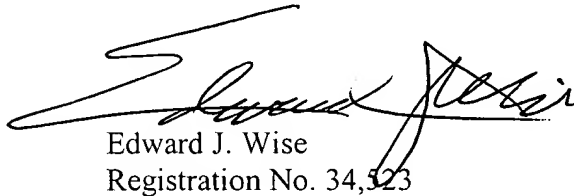
**CONCLUSION**

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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